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Art Unit : 3628

Attorney Docket No. 18433.00

REMARKS

By the present amendment, Applicants have amended Claims 1, 6, 8, 11 and 12, and added Claims 15-20. Claims 1-20 remain pending in the present application. Claims 1, 11 and 15 are independent claims.

Applicants appreciate the courtesies extended to Applicants' representative during the personal interview held January 31, 2003. The present response summarizes the substance of the interview. At the interview proposed new Claims 15-20 were presented. Proposed independent Claim 15 set forth additional limitations not present in previous independent Claims 1 and 11, notably the barrier disposed between the battery and the vibratory unit was added as an element of the claim, and the post together with the limitations which enable the post to activate the vibratory unit was also added as an element of the claim. In addition, potential language for amending Claim 1 in the event that Applicants elect to file a Section 131 Declaration to swear behind the Klein reference (U.S. Patent No. 6,419,649) was discussed. Arguments were

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advanced that new Claims 15-20 distinguish over the prior art. The Examiner indicated that new Claims 15-20 defined over the prior art of record and would be allowable, subject to further search. The Examiner also indicated that a properly filed Declaration under Rule 131 would serve to overcome the rejection of Claims 1-14 under 35 USC 102(e).

In the recent Office Action the Examiner rejected Claim 8 under 35 U.S.C. § 112, first paragraph, as containing subject matter not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention. The Examiner rejected Claims 1-14 under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants have amended Claim 8 to insert language that the keeper is configured to receive --an attachment selected from the group consisting of--"a chain, charm and ornamental item." Also, Claims 1, line 6, and Claim 11, line 5, have been amended to change "said battery" to read --said power source--. Applicants have also deleted the alternative language "pierced or unpierced" from the preambles of Claims 1 and 11; changed "the user" to --a user-- in the preamble of Claims 1 and 11 to

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eliminate antecedent basis problems. In addition, Claims 6 and 12 have been amended to positively recite --a threaded recess defined in the second section-- to eliminate antecedent basis problems. Applicants respectfully submit that Claims 1-14, as amended, meet the specific requirements of 35 U.S.C. § 112, first and second paragraphs.

In the recent Office Action the Examiner rejected Claims 1-2, 4-7, and 11-13 under 35 U.S.C. § 102(e) as being anticipated by Klein. Claims 3 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Klein in view of Riley (U.S. Patent No. 5,048,310). Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Klein in view of Erickson (U.S. Patent No. 4,781,036). Claims 9 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Klein in view of Moody (U.S. Patent No. 4,840,045)

Applicants propose to file an Declaration under 37 C.F.R. § 1.131 to remove the Klein patent as a reference. Applicant's attorney of record has evidence that Applicants were in possession of the invention prior to April 5, 2000, which is the effective filing date of the Klein application. A properly

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executed Rule 131 Declaration is expected to be submitted before the Examiner picks up the application for reconsideration of the present amendment. Since Klein is the only reference applied to reject independent Claims 1 and 11, the Declaration should serve to overcome the rejection of independent Claims 1 and 11, as amended, and corresponding dependent Claims 2-10 and 12-14, respectfully.

In addition, Applicants have amended Claims 1 and 11 to delete the "actuation means" as an element of the claim, and added the post as an element, further specifying that the housing is disposed on one end of the post to further distinguish the claims of the present invention from the claims in Klein. Applicants have deleted the reference to actuation means from Claims 6 and 12, accordingly.

As discussed at the aforementioned interview Applicants have added new Claims 15-20, which add a barrier disposed between the battery and the vibrating motor unit in independent Claim 15. This provides an insulator which prevents accidental activation of the vibrating unit. The barrier is described at p. 8, lines 1-3, and p. 8, line 22 through p. 9, line 6, and

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shown in Figs. 2 and 3 of the drawings. No new matter has been added. Klein fails to show or suggest such an insulating element in the discussion of the embodiment shown in Figs. 4 and 5. Assuming that the embodiment in Figs. 4-5 of Klein is activated in the same manner as the embodiment of Figs. 1-3, the Klein device is subject to accidental activation of the vibrator whenever the battery contacts the vibratory motor contact; otherwise, the embodiment of Figs. 4 and 5 must always be "on" whenever the two housing sections are snapped together. For this reason, Applicants submit new Claims 15-20 are patentable over the prior art of record.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

No Notice of Draftsperson's Patent Drawing Review (PTO-948) was included as an attachment to the recent Office Action. Applicant requests that this PTO form be attached to the Examiner's next correspondence. Any objections to the drawings as filed will be taken care of no later than upon submission of the issue fee.

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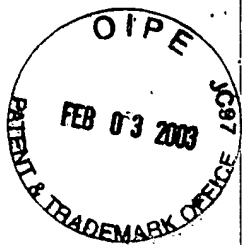
For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the claims:

Claims 1, 6, 8, 11 and 12 have been amended as follows.

1. (Amended) A vibrating body jewelry item to be attached to [either] a [pierced and unpierced] body part of [the] a user, comprising:

a power source;

a vibrating motor unit;

a housing having a first and second section dimensioned and configured to contain said [battery] power source and said vibrating motor unit, each said first and second sections having mating ends that connect to one another;

[an actuating means for activating said vibrating motor;
and]

[an] attachment means for securing the vibrating body jewelry item to a body part of a user; and

a post, said housing being disposed at one end of said post, and said attachment means being disposed at an opposite end of said post;

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wherein said power source and said vibrating motor unit are disposed within said housing.

6. (Amended) The vibrating body jewelry item according to claim 1, wherein said [actuating means for activating said vibrating motor unit is a] post [having at least one end dimensioned and configured to threadingly fit through said recess in said second section of said housing] has a threaded end and said housing has a threaded recess defined in the second section, and wherein said post extends through the threaded recess in the second section in order to move said power source onto said vibrating motor unit thereby activating said vibrating motor unit.

8. (Amended) The vibrating body jewelry item according to claim 7, wherein said keeper is configured to receive an attachment selected from the group consisting of a chain, charm, and other ornamental jewelry piece item.

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11. (Amended) A vibrating body jewelry item to be attached to [either] a [pierced and unpierced] body part of [the] a user, comprising:

a power source;

a vibrating motor unit;

a housing dimensioned and configured to contain said [battery] power source and said vibrating motor unit;

[an actuating means for activating said vibrating motor; and]

[an] attachment means for securing the vibrating body jewelry item to a body part of a user;

a post, said housing being disposed at one end of said post, and said attachment means being disposed at an opposite end of said post;

wherein said power source and said vibrating motor unit are disposed within said housing.

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12. (Amended) The vibrating body jewelry item according to claim 11, wherein said post has a threaded end and said housing [further includes means] has a threaded recess formed therethrough [for said actuating means], and wherein the threaded end extends through the threaded recess in order to selectively engage said vibrating motor unit with said power source.